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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER TOOP

Appeal 2009-0603
Application 10/633,209
Technology Center 3700

Decided:[1] March 30, 2009

Before WILLIAM F. PATE III, LINDA E. HORNER, and
JOHN C. KERINS, Administrative *Patent Judges*.

WILLIAM F. PATE III, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

This is an appeal from the final rejection of claims 1-5 and 7. These are the only claims remaining in the application. We have jurisdiction over the appeal under 35 U.S.C. §§ 134 and 6.

The claimed invention is directed to an intraocular lens for a toric optic wherein the haptics have a proximal part and a distal part with the thickness of the region of the distal part being greater than the rest of the haptic.

Claim 1, reproduced below, is further illustrative of the claimed subject matter.

> 1. An intraocular lens comprising a toric optic and one or more haptics, each haptic having a proximal part and a distal part, wherein the thickness of a region of the distal part of the, or each, haptic is greater than the rest of the haptic, such that rotation of the lens is inhibited in use.

REFERENCES

The references of record relied upon by the examiner as evidence of obviousness are:

Blake	US 6,425,917 B1	Jul. 30, 2002
Toop	EP 0 962 196 A1	Dec. 8, 1999

REJECTIONS

Claims 1-5 and 7 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Toop in view of Blake.

ISSUES

Appellant argues that the Examiner fails to make a prima facie case of

obviousness due to the fact that Blake is principally intended for placement in the anterior chamber of the eye rather than in the posterior chamber. Appellant further argues that Blake does not disclose an advantage or suggestion of desirability in connection with the haptic having a thicker distal part. Appellant further argues that one of ordinary skill when viewing Blake would not recognize that Blake finds it necessary to stabilize or inhibit rotation with respect to the toric optic. Appellant also argues that one of ordinary skill would not place the intraocular lens of Blake in the capsular sac, inasmuch as the capsular sac, when contracting, would lead to twisting and buckling of the haptic or piercing of the sac.

In the Reply Brief, Appellant continues to argue that Blake is for placement in the anterior chamber of the eye and that placement of Blake in the capsular sac would lead to haptic failure of the Blake lens. Finally, Appellant argues that Blake fails to disclose an advantage in providing a thicker haptic, and that the thicker distal region of the elastomer-coated haptic in Blake is merely an incidental effect.

ISSUE

The sole issue for our consideration is whether Appellant has established that the Examiner erred in rejecting claims 1-5 and 7 under 35 U.S.C. § 103(a).

FINDINGS OF FACT

1. Toop discloses an intraocular lens having an optical region and two curved haptics. Para. [0009]. The haptics disclosed in Toop are compressible and are shaped such that during the first stage of compression, the proximal part of the haptic can be fully compressed and in the second

stage, the distal part of the haptic is compressed. Para. [0014]. When the haptics are entirely compressed they form an essentially elliptical form within the lens or capsule of the eye. Para. [0013]. Toop differs from the claimed subject matter in that the distal part of the haptic is not thicker than the proximal part.

2. Blake discloses an intraocular lens with an optic 200 and compressible haptics to stabilize the position of the optic in the eye. Blake states that the lens optic 200 can be of any type of lens and specifically mentions a toric or aspheric lens. See col. 5, ll. 51-57.

3. The invention of Blake is principally directed to a dual composition haptic with a high modulus portion and a lower modulus portion, partially or completely covering the high modulus portion of the haptic. The purpose of the lower modulus material (an elastomer) is to extend beyond the tip of the haptic to produce a softer contact point for the eye tissue. See col. 3, ll. 27-30. In another location in the patent, Blake refers to this contact as a softer atraumatic contact point or lip which rests against the eye tissue. See col. 4, ll. 63-65; col. 9, l. 67. Thus Blake gives an express, written advantage of using the elastomer on the distal end of the haptic. Blake also mentions reducing discomfort as an advantage. See col. 10, l. 4.

4. Blake states that the intraocular lens disclosed in the patent may be used anteriorly or posteriorly in the eye but is particularly or especially suited for use in the anterior chamber. See col. 4, ll. 50-54. At col. 5, ll. 1-23, Blake suggests that the intraocular lens can be capsularly implanted. In this passage Blake describes how a lens is placed in a capsular sac. Then in lines 20 and 21, Blake states that the instant lens may be implanted in the

procedure outlined above. Thus, Blake clearly discloses that, while not preferred, this intraocular lens could be emplaced in the capsular sac.

5. The elastomeric portion 300 disclosed in Blake can be seen as thicker at the distal portion than at the proximal portion of the haptic in Figures 3B, 4C, 5B, 5D, 5F, 5H, 5J, 5L and 7B. One method for placing the elastomer on the haptic is dip coating. See Example 1 at col. 11, ll. 5 and 6 and col. 11, ll. 9-11. It is our finding that the dip-coated elastomer when applied on the higher modulus haptic naturally makes the haptic distal end thicker than the haptic proximal portion.

PRINCIPLES OF LAW

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, ___, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. 398 at ___, 127 S. Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.").

"The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference .... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (citations omitted); *see also In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983) ("[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review."); *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973) ("Combining the *teachings* of references does not involve an ability to combine their specific structures.").

The law does not require that the references be combined for the reasons contemplated by the inventor. *In re Beattie,* 974 F.2d 1309, 1312 (Fed. Cir. 1992), *citing In re Kronig,* 539 F.2d 1300, 1304 (CCPA 1976) and *In re Lintner,* 458 F.2d 1013, 1016 (CCPA 1972). "[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *KSR,* 550 U.S. at ___, 127 S. Ct. at 1742 (finding that the Court of Appeals erred in holding that courts and patent examiners should look only to the problem the patentee was trying to solve.).

ANALYSIS

Based on our factual findings, we are in agreement with the Examiner that it would have been obvious to make the distal portion of Toop thicker than the proximal portion by placing an atraumatic elastomeric coating on the distal portion for the advantage of providing a gentle contact with the eye

tissue. This is merely combining prior art elements according to known methods to yield predictable results. We further agree that by following Example 1 of the Blake patent and dipping the distal end of the haptic, the haptic would be thicker than the proximal portion.

Appellant argues that there is no apparent reason to combine the known elements of Toop and Blake. As noted above, there is ample motivation and an expectation of success with respect to the elastomeric coating and the distal end of the haptic.

Appellant argues that Blake is merely for placement in the anterior chamber of the eye. This is belied by multiple places in the Blake specification that teach that the toric optic of Blake could be placed in the posterior section of the eye, and one particular passage of Blake, wherein it is stated that Blake can be implanted in the capsular sac itself. Finding 4. Thus, we do not credit Appellant's argument that Blake is only for anterior application.

Appellant argues that there is no advantage or suggestion of desirability given by Blake for a thicker distal part. This argument also is not credited, as the Examiner has pointed to several express statements in the Blake patent that refer to gentle or atraumatic contact. Blake also refers to patient discomfort.

Appellant argues that the present invention solves a problem different from both Toop and Blake. However, the references in an obviousness rejection need not be combined for the reasons or purpose of Appellant's invention.

Appellant argues that if the haptic of Blake were to be placed in a capsular sac, then the haptic would fail. There is no evidence that this is the

case. Furthermore, obviousness does not require bodily incorporation of the structures of the references. Here, Blake merely teaches that the outer surface of the haptic should be made thicker for gentler contact with eye tissue.

Appellant further argues that the reason to combine the cited references is found in hindsight. This is clearly not the case, inasmuch as the rationale for combining the references is not for the reason stated in Appellant's specification.

In the Reply Brief, Appellant again argues that Blake is intended for the anterior chamber of the eye. It is our finding that while anterior placement may be preferred, Blake does suggest and discuss placement of the haptics of his invention in the posterior portion of the eye and even in the capsular sac. Appellant argues that when Blake states that it is envisioned that the lens could be implanted in the posterior chamber, it is clear that Blake has not done so. An actual reduction to practice is not required of the Blake reference for it to be a considered a patent-defeating disclosure under either § 102 or § 103. We further note that Appellant has not argued that the Blake disclosure is non-enabling and has not even mentioned undue experimentation. At any rate, this is an individual attack on the reference where the rejection is based on a combination of references. "Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references." *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)).

Appellant again argues that the placement of the haptic in the capsular sac would cause the haptic to fail. This argument is based on the bodily

incorporation of the haptic of Blake on the Toop lens. Obviousness does not require bodily incorporation. It is the teaching of Blake to apply an atraumatic coating on the haptic. It is this coating which would be applied to the haptic of Toop.

Appellant describes the thicker elastomer coating of the haptic of Blake as merely an incidental effect. This is belied by Blake's repeated reference to the gentle or atraumatic contact generated by the distal elastomeric coating.

CONCLUSION

For the foregoing reasons, the Appellant has failed to establish that the Examiner erred in rejecting claims 1-5 and 7 under 35 U.S.C. § 103(a). The rejection of these claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

vsh

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